

Part III DETAILED ACTION

*** This communication is providing a more description of the species including the constructively non-elected species, and the elected/constructively elected species.

*** First, note that this application presently contains only two independent claims 41 and 166. Claims 41 and 166 are also generic claims (currently examined, see the office action mailed July 21, 2009).

Accordingly, upon the allowance of a generic claims 41 and 166, applicant will be entitled to consideration of claims to *additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141*. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

*** Second, Claims 41 and 166 are generic to the following disclosed patentably distinct species:

- ** Species I, elected or constructively-elected, including claims 43,44, 46,51,53-54, 56-65,96,100-101, 103-117,124-132,135-143,149-150,152-154,160-165, 167-174,176-184,192-197, and 204-205, for printing a composition and curing the composition.
- ** Species II, with a passivation layer, where:
 - * The passivation layer comprises an alcohol, a thiolate, an alkaryl group, an aryl group, or aralkyl group, etc., (e.g. claims 97+,200-203);
 - * The passivation layer comprises hydrogen atoms (e.g. claim 98+); and
 - * The passivation layer comprises a surfactant (e.g. claims 99+).
- ** Species III, with a solvent, where:
 - * The solvent is aprotic (e.g. claims 118+, 185+);
 - * The solvent is apolar (e.g. claims 119+, 186+); and
 - * The solvent is a gas-phase dipole (e.g. claims 144+,146+, 190+).
- ** Species IV, with removing the solvent and cleaning with solvent (claims 155+, 198+).

The species are independent or distinct because as disclosed the different species have the *mutually exclusive characteristics* for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions/species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention/species and a nonelected invention/species and examination of the formerly nonelected invention/species on the merits. In order to be eligible for rejoinder, *a claim to a nonelected invention/species must depend from or otherwise require all the limitations of an allowable claim*. A withdrawn claim that does not require all the limitations of an allowable claim will not be rejoined. In order to retain the right to rejoinder, applicant is advised that the claims to the nonelected invention(s)/species should be amended *during* prosecution to require the limitations of the elected invention. Failure to do so may result in a loss of the right to rejoinder. See MPEP 821.04 for rejoinder procedure, requirement, and timely amendments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Trinh whose telephone number is (571) 272-1847. The examiner can normally be reached on M-F, 9:00 Am to 5:30 Pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zandra Smith can be reached on (571) 272-2429. The central fax phone number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Michael Trinh/

Primary Examiner, Art Unit 2822